

REMARKS

Entry of the foregoing amendment is respectfully requested. The Amendment is believed to place the application in condition for allowances and is, therefore, appropriate under Rule 116. The Amendment does not raise any new issues and, thus, does not require an additional search by the Examiner. The issues raised by the new claim 9 are the same issues raised by the presently pending claim 1.

The Amendment was not earlier presented because applicant did not fully appreciate the grounds for rejection until they were set forth in the final Office Action.

By the present amendment, claim 1 is canceled , and claim 9 is added. Claim 9 corresponds in scope to claim 1 that is rewritten only to improve its language. Claim 2 is amended to provide its proper dependency.

Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance and action to that end is respectfully requested.

The Examiner rejected claims 1 through 7 under 35 U.S.C. § 103(a) as being unpatentable over Olvera et al., U.S. Patent No. 5,897,045 in view of Lin, U.S. Patent No. 6,779,697 (Lin). Claim 8 was rejected as claims 1-7 above and further in view of Caringella et al., U.S. Patent No. 6,761,299 (Caringella). It is respectfully submitted that claims 2-9 are patentable over the combination set forth in the Office Action.

Specifically, claim 9 recites a head piece which is arranged at the outlet opening (10) of the guide pipe with a possibility of rotation relative to the rest of the drive-in device and relative to the pipe arrangement. With the only head piece being rotated, all other device components, including the pipe arrangement, remain stationary with respect to the device handle arrangement, which permits the device user to walk straight ahead while driving the fasteners in, even with the orientation of the profiled workpieces being changed.

It is respectfully submitted that the present invention would not be obvious in view of the prior art, including Olvera and Lin. Olvera, as it is noted by the Examiner, does not disclose a rotatable head piece. Lin discloses a tool in which the magazine is connected to the tool barrel (head piece) for joint rotation therewith relative to the rest of the tool. Thus, Lin suggests rotating the fastener feed means together with the barrel (head piece). Accordingly, if Olvera were to

be modified in view of Lin, Olvera would have a head piece rotatable together with the pipe arrangement and not relative to the pipe arrangement, as recited in claim 1 of instant application.

Under MPEP, § 2143 *prima facie* case of obviousness requires that three basic criteria be met.

First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitation.

It is respectfully submitted that at least the third criterium of obviousness has no been met.

Because the combination of Olvera and Lin does not disclose or suggests all of the limitations of claim 9, it is respectfully submitted that the present invention, as defined by claim 1, is not rendered obvious by the combination of Olvera and Lin, and claim 9 is patentable over said combination.

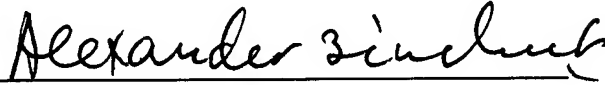
Claims 2-8 depend on claim 9 and are allowable as being dependent on an allowable subject matter.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place the case in condition for final allowance, it is respectfully requested that such amendment or correction be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,


Alexander Zinchuk
Reg. No. 30,541

Dated: August 10, 2005
Abelman, Frayne & Schwab
666 Third Avenue, 10th Floor
New York, NY 10017-5621
212-885-9386

This correspondence is being deposited with the United States Postal Service on August 10, 2005 in an envelope as "Express Mail Post Office to Addressee" Mailing Label Number ER 843 204 780 US addressed to the Honorable Commissioner for Patents, Alexandria, VA 22313-1450.


Alexander Zinchuk

